

REMARKS

History and Status of Application

In the July 17, 2007 Office Action, claims 2, 3, 5, 8-12, 14, 15, 17, 21-23, 25, 27, 29-31 and 33-35 were allowed. Claims 6, 7 and 19 were objected to. Claims 18, 20, 28 and 32 were rejected as anticipated under 35 U.S.C. §102(e) (as §102(a) prior art) by U.S. Patent No. 6,851,211 to Sender ("the Sender '211 patent").

The July 2007 Office Action noted that the inventor of the Sender '211 patent is a co-inventor of the present application. The Office Action further confirmed that this rejection would be removed upon presentation of a declaration under 37 C.F.R. 1.132 showing that the Sender '211 patent was not "by another." A §1.132 declaration of Mr. Sender was provided together with Amendment C on January 17, 2008. A copy of that Declaration is enclosed. That Declaration establishes that claims 18, 20, 28 and 32 and the subject matter of the Sender '211 patent were commonly invented by Mr. Sender, that the Sender '211 patent is therefore not "by another," and should be effective to overcome the rejection of these claims. Removal of this rejection would likewise render the objections to claims 6, 7 and 19 moot. All claims would be allowed.

October 2008 Notice of Abandonment

On October 7, 2008 a Notice of Abandonment was mailed. That Notice of Abandonment indicated that the §1.132 Declaration filed in January 2008 was improper and not entered due to an alleged deficiency, that the Final Rejection was therefore not withdrawn, and that the application went abandoned.

The nature and details of the alleged deficiency in the Declaration were not provided in the Notice of Abandonment, except for a conclusory indication that the Declaration did not comply with MPEP §716.10. Multiple phone calls have been placed to the Examiner to discuss the alleged deficiency in the Declaration without any resolution. The Examiner has not been able to inform the undersigned attorney in what particular respect the Declaration is deficient.

The Examiner indicated that she was not experienced in dealing with similar Declarations (that in fact this was the first such Declaration she had handled) and had sought the advice of an unnamed colleague experienced in such Declarations when it was first filed in January 2008. That colleague advised her that the Declaration was deficient, the Examiner refused entry and declared the application abandoned.

In further reviewing the matter following the Notice of Abandonment, the Examiner stated that she had spoken with her supervisor, and that the supervisor was “on the fence” as to whether the Declaration was deficient or not. The Examiner continued to be unable, however, to specify in what particular manner the declaration was allegedly deficient. The Examiner recommended that the matter could only be resolved through filing of a Petition to Revive since the application was abandoned.

The Sender Declaration Complies with MPEP §716.10 and Should be Entered

It is submitted that the Declaration complies with MPEP §716.10. That section of the MPEP states that "An uncontradicted ‘unequivocal statement’ from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship." It is submitted that the Declaration includes such statements – Declarant Edward Sender states that “he is the sole inventor of ...” the claims at issue and of U.S. Patent No. 6,851,211.

It is submitted that this statement can only be interpreted as an uncontradicted unequivocal statement that Mr. Sender is the inventor of all of the subject matter of the relevant claims and the subject matter disclosed in that patent. Indeed, Mr. Sender is the only inventor named on the face of the ‘211 patent, meaning that under the laws of the United States and rules and regulations of the Patent Office there is a legal presumption that Sender is the only inventor of such subject matter.

Should the Declaration not be entered, detailed clarification of its alleged deficiency is requested so that the same may be resolved.

Enclosed IDS

A supplemental IDS is enclosed herewith disclosing an alleged offer for sale by a third party of a prior art apparatus. This alleged offer for sale was brought to the Applicant's attention together with sketches of an alleged prototype solar powered rotating display sign suspended from a ceiling that were allegedly presented by a third party to a potential customer in the late 1980's. The sketches are provided with the enclosed IDS.

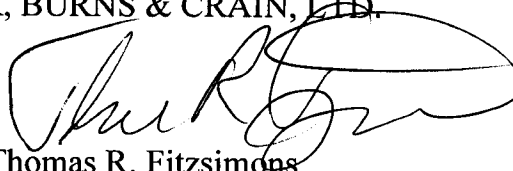
Conclusion

Applicant has invested significant time and expense in resolving the alleged deficiency of the enclosed Declaration. It is believed that no such deficiency in fact exists, that the Declaration should be entered, and that all rejections of the claims should therefore be withdrawn. Should these actions not be taken, clarification as to the particular deficiency in the Declaration is required. The Examiner is invited to contact the undersigned attorney by phone should any matters remain for attention before a Notice of Allowance can be issued.

Respectfully submitted,

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By


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